

## REMARKS

Claims 1-6 remain in the application. Reconsideration of this application, in view of these remarks, is respectfully requested.

Claim 1 was rejected under 35 U. S. C. § 102 (b) as being anticipated by Böcker et al. (US 5,507,288) in view of Cheung et al. (US 5,074,977). This rejection is respectfully traversed for the following reasons.

Böcker et al., U. S. Patent No. 5,507,288 (hereinafter "Böcker et al."), discloses an integrated analysis-element/sensor system IASS comprising a sensor unit borne on the body of a patient and a central unit linked with the sensor unit by wireless data transmission. The central unit comprises the typical features of an evaluation instrument commonly used in element-analysis systems. It serves to evaluate an analysis-element in the form of a glucose test strip with a base layer and a test zone. For evaluation, the analysis-element is inserted into test duct located beneath a flap of the device. A keypad is provided to operate the central unit. A display serves as information output, in particular to display analytical data. An evaluation curve may be permanently stored in the central unit. Preferably, a separate, batch-specific evaluation curve is used for each new manufactured batch of analysis-elements and is transmitted to the central unit by means of a suitable data medium in machine-readable form. For that purpose, the central unit comprises a data reader, e.g., a barcode reader, to read a barcode affixed to the analysis-element itself or to an additional code carrier. The barcode is included in each pack of analysis-elements and contains the batch-specific evaluation curve.

Cheung et al., U. S. Patent No. 5,074,977 (hereinafter "Cheung et al."), discloses a keypad and display to allow operator inputs and information outputs to be effected.

The examiner stated that claim 1 is anticipated (35 U. S. C. § 102 (b)) by Böcker et al. in view of Cheung et al. However, the Examiner further states that it would have been obvious to incorporate the conventional keypad as taught by Cheung et al. into the teachings of Böcker et al. in order to provide the user with a more flexibility in selecting which test to perform and in



inputting the necessary data. Applicants will address this rejection as if it were based on 35 U. S. C. § 103.

Böcker et al. does not disclose or suggest a numeric keypad. Cheung et al. does not disclose or suggest a barcode reader. Thus, neither reference suggests the data entry mode employed by the other reference. It follows then, that neither reference suggests the combination of a barcode reader and a numeric keypad. The suggestion that a certain modification be made in the basic reference must come from the other ("teaching") reference, and not from applicant. Where a person, having the reference before him who was not cognizant of the applicant's disclosure, would not be informed that the problem solved by the applicant ever existed, then it cannot be said that these references, which never recognized applicant's problem, would have suggested its solution. Such references are improperly combined since there is no suggestion in any of them that they can be combined to produce applicant's result. Absence of a suggestion in any one of the references that the process of one should be combined with the features of another to achieve the results of which neither reference is capable requires a holding that the rejection on the combination of the references is improper. It is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done. If the art did not do so, the references may have been improperly combined. In order to negate invention it is necessary to find in the prior art not merely a device which might be modified to make this construction, but somewhere a suggestion not only that the modification ought to be made but how to make it.

Accordingly, it is submitted that there is no suggestion in either of the references cited by the Examiner to provide a hand-held analyte test instrument having two different modes of data entry. In view of this reason, it is submitted that the combination of Böcker et al. and Cheung et al. fails to render claim 1 obvious to one of ordinary skill in the art. It is assumed that anticipation is not a valid ground of rejection.

Claim 3 was rejected under 35 U. S. C. § 103 (a) as being unpatentable over Davis (US 5,502,943) in view of Koenck et al. (US



5,324,925) and Davis et al. (US 5,828,966). This rejection is respectfully traversed for the following reasons.

Davis, U. S. Patent No. 5,502,943 (hereinafter "Davis"), discloses a dock apparatus for receiving of portable, hand-held data retrieval devices to allow recharging of internal batteries and data communication with centralized computer systems. A frame having electrical contact elements at its inner end receives the hand-held device, which at its lower end is provided with electrical contact pads which engage the contact elements of the receiving frame when the hand-held device is fully inserted in the frame. Detents within the frame engage mating indentations in the hand-held device. The dock frames may be ganged in plural arrangements.

Koenck et al., U. S. Patent No. 5,324,925 (hereinafter "Koenck et al."), discloses a hand-held portable terminal, comprising:

- (a) a housing having a front section and a rear section, a forward end and a rearward end, said front section being hinged to said rear section;
- (b) key means being disposed within said housing for entering information into said terminal;
- (c) display means disposed within said housing for displaying information;
- (d) a low power, frequency hopping, transceiver means disposed at least partially within said housing for receiving and transmitting information by said terminal;
- (e) scanning means disposed within said housing for optically reading information stored in coded information sets;
- (f) battery means disposed within said housing for providing electrical power thereto; and
- (g) means, disposed within said housing, for processing information input and output said terminal.

Davis et al., U. S. Patent No. 5,828,966, (hereinafter "Davis et al."), discloses a charging cradle adapted to hold a telephone in a nested relation while recharging the batteries located within the telephone. Safety features prevent overcharging.

Koenck et al. discloses a docking station having a plurality of data ports. However, Koenck et al. does not disclose or suggest a docking station



having a first data port being electrically connectable to a computer and a second data port being electrically connectable to a peripheral device, the docking station being configured to pass data between the analyte test instrument and the first data port when the docking station is in a default condition. While Davis does generally disclose a dock apparatus to allow recharging of internal batteries, Davis does not remedy the aforementioned deficiencies of Koenck et al. While Davis et al. does generally disclose safety features to prevent overcharging, Davis et al. does not remedy the aforementioned deficiencies of Koenck et al. Thus, the combination of Davis, Koenck et al., and Davis et al. fails to disclose or suggest a docking station that includes (1) a first data port being electrically connectable to a computer, (2) a second data port being electrically connectable to a peripheral device, and (3) a docking station being configured to pass data between the analyte test instrument and the first data port when the docking station is in a default condition. For this reason, it is submitted that the combination of Davis, Koenck et al., and Davis et al. does not render claim 3 obvious to one of ordinary skill in the art.

Claim 4 was rejected under 35 U. S. C. § 103 (a) as being unpatentable over Brown (US 5,307,263) in view of Cheung et al. This rejection is respectfully traversed for the following reasons.

Brown, U. S. Patent No. 5,307,263 (hereinafter "Brown"), discloses a modular self-care health monitoring system which employs a small handheld microprocessor-based unit such as a compact video game system of the type that includes a display screen, switches for controlling device operation and a program cartridge that is inserted into the handheld unit to adapt it for operation with a microprocessor-based healthcare data management unit and a glucose monitor or another type of health monitor. A modem, included in the microprocessor-based healthcare data management unit, allows data such as blood glucose level to be transmitted to a clearinghouse, which transmits reports to a remotely located healthcare professional via facsimile transmission.

The Examiner's reasons for the rejection relate to Severt et al. and not to Brown. See the paragraph bridging pages 5 and 6 of the Office Action.



Accordingly, Applicant is unable to respond to the rejection. For this reason, this rejection should be withdrawn.

Claims 2 and 5-6 were rejected under 35 U. S. C. § 103 (a) as being unpatentable over Böcker et al. (US 5,507,288) in view of Cargin Jr. et al. (US 5,602,456). This rejection is respectfully traversed for the following reasons.

Cargin Jr. et al., U. S. Patent No. 5,602,456 (hereinafter "Cargin Jr. et al."), discloses a battery pack system for providing rechargeable battery power for a portable data collection terminal and for enabling recharging while received in power supplying relation to such a terminal.

Böcker discloses a barcode reader. Cargin Jr. et al. discloses a user interface capable of allowing an operator to enter data. Neither Böcker nor Cargin Jr. et al. discloses or suggests an analyte test instrument having both a user interface capable of allowing an operator to enter data and a barcode reader disposed in the housing for scanning a barcode associated with a test strip configured to receive an analyte. Moreover, neither Böcker nor Cargin Jr. et al. contains a suggestion to combine (1) a barcode reader disposed in the housing for scanning a barcode associated with a test strip configured to receive an analyte and (2) a user interface capable of allowing an operator to enter data in an analyte test instrument. The suggestion that a certain modification be made in the basic reference must come from the other ("teaching") reference, and not from applicant. Where a person, having the reference before him who was not cognizant of the applicant's disclosure, would not be informed that the problem solved by the applicant ever existed, then it cannot be said that these references, which never recognized applicant's problem, would have suggested its solution. Such references are improperly combined since there is no suggestion in any of them that they can be combined to produce applicant's result. Absence of a suggestion in any one of the references that the process of one should be combined with the features of another to achieve the results of which neither reference is capable requires a holding that the rejection on the combination of the references is improper. It is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done. If the art did not do so, the references may have been improperly



combined. In order to negate invention it is necessary to find in the prior art not merely a device which might be modified to make this construction, but somewhere a suggestion not only that the modification ought to be made but how to make it. Accordingly, the combination of Böcker and Cargin Jr. et al. is improper and cannot render claims 2 and 5-6 obvious to one of ordinary skill in the art.

In view of the foregoing, it is submitted that claims 1-6 are in condition for allowance, and official Notice of Allowance is respectfully requested.

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